

Application No. 10/575,147
Response dated: June 30, 2008
Reply to Non-Final Office Action dated: March 28, 2008

REMARKS

The above amendments are made in response to the outstanding Office Action date March 28, 2008. The Examiner's reconsideration is respectfully requested in view of the above amendments and the following remarks.

Claim 1 has been amended in order to more clearly define the subject matter of the claimed invention. Claim 8 has been cancelled, of which subject matter is incorporated into the amended Claim 1. Claims 11-13 have been withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over van der Slot, et al. (*Organometallics*, 2002, 3873-3883; hereinafter, "van der Slot") in view of Billing, et al. (*Kirk-Othmer Encyclopedia of Chemical Technology*, 1996, "Oxo Process" Pages 1-17; hereinafter, "Billing").

In order for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143.

Establishing a *prima facie* case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish

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obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In re Skill*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Applicants have amended Claim 1 to incorporate the subject matter of Claim 8, which is now cancelled. Claims 2-7, 9 and 10 are dependent directly or indirectly from Claim 1.

The amended Claim 1 includes, *inter alia*, the following limitations.

"the concentration of the transition metal is 50 to 500 ppm based on the amount of the catalyst composition, and the concentration of the bidentate ligand is 0.5 to 20 mol and the concentration of the monodentate ligand is 0.1 to 50 mol, respectively per mol of the transition metal" (Emphasis added)

As stated above, the claimed invention limits the concentration of the transition metal to 50 to 500 ppm based on the amount of the catalyst composition, and the contents of the bidentate ligand and the monodentate ligand to 0.5 to 20 mol and 0.1 to 50 mol, respectively, per mol of the transition metal, thereby enabling to improve both the catalytic activity and stability, as described in lines 10-27 on page 6 of this application.

However, van der Slot and Billing, either alone or in combination, does not teach or suggest the above limitations to the contents of the transition metal, the bidentate ligand and the monodentate ligand, as recited in the amended Claim 1.

It is therefore submitted that neither van der Slot nor Billing, either alone or in combination, teaches or suggests the subject matter claimed in amended Claim 1, and thus *no suggestion or motivation* exists in the cited references. Accordingly, *prime facie* obviousness does not exist regarding the subject matter claimed in Claim 1 with respect to the cited references. Applicants

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respectfully submit that Claim 1 is now allowable. Claims 2-7, 9 and 10 are also believed to be allowable, by means of their direct or indirect dependency from Claim 1.

Applicants respectfully request the Examiner to consider these submissions and withdraw the rejection on Claims 1-10 under 35 U.S.C. § 103.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Reconsideration and subsequent allowance of this application are courteously requested.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

The Examiner is invited to contact Applicant's Attorneys at the below-listed telephone number with any questions or comments regarding this Response or otherwise concerning the present application.

Respectfully submitted,

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